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AF/2837

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANT: Zaharia, et al.
SERIAL NO.: 09/778,481
FILED: 02/07/2001
EXAMINER: Salata
GROUP ART UNIT: 2837
FOR: ELEVATOR INSPECTION DEVICE ARRANGEMENT

REPLY BRIEF

Box AF
Commissioner For Patents
P. O. Box 1450
Alexandria, VA 22313-1450

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Dear Sir:

This is responsive to the Examiner's Answer, which was mailed on October 22, 2003.

Applicant thanks the Examiner for withdrawing the rejection under 35 U.S.C. §112, first paragraph.

With regard to the enablement rejection, any claim that reads upon a disclosed embodiment is necessarily enabled. As pointed out in Applicant's brief, every claim finds direct support in the specification.

The Examiner appears to be contending that Applicant has not explicitly described every possible scenario in which the claimed invention could be used and that somehow renders the specification non-enabling. All that is required is that the claims be supported by the specification in a manner that conveys to one skilled in the art how to practice the claimed invention. The examples provided in the specification and drawings walk the skilled artisan through the process of practicing the claimed invention.

Regarding the rejection under 35 U.S.C. §103, the motivation for modifying the *Yamagami* reference is missing and there is no *prima facie* case of obviousness. What possible motivation is there for one skilled in the art looking at *Yamagami*, which relies upon contact sensing immediately adjacent a sheave, to replace that arrangement with a completely different type of sensor such as that shown in *Hirama, et al.*? There is none. The two systems are incompatible and the only justification for trying to combine them is using Applicant's claims as a road map to piece together portions of the prior art.

It is axiomatic that there must be a sufficient legal motivation from within the references to suggest a modification or combination that would result in a claimed invention to establish a *prima facie* case of obviousness. In this instance, there is no such motivation.

Further, as previously pointed out many of the claims contain limitations that cannot be found in the cited references. Not one of the references suggests, in any way, considering any of the system variables or characteristics discussed and claimed by Applicant for the purposes of practicing the claimed invention. The claimed approach to placing a sensor in an elevator system, which is fully described in Applicant's specification, is nowhere found in the art in any combination. Therefore, at a minimum, even if there were some basis for making the proposed combination, the result is not the same as any of the method claims.

Applicant respectfully submits that all rejections should be reversed.

Respectfully submitted,

CARLSON, GASKEY & OLDS, P.C.

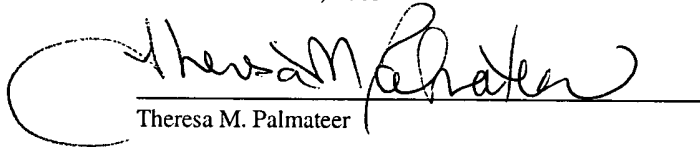


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Dated: December 22, 2003

CERTIFICATE OF MAILING

I hereby certify that the enclosed **Reply Brief (in triplicate)** is being deposited with the United States Postal Service as First Class Mail, postage prepaid, in an envelope addressed to Mail Stop AF, Commissioner for Patents, P. O. Box 1450, Alexandria, VA 22313-1450 on December 22, 2003.


Theresa M. Palmateer

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